

REMARKS

The Office Action dated November 28, 2005 has been received and carefully studied.

The Examiner rejects claims 1-34 under 35 U.S.C. §101 because the invention is directed to non-statutory subject matter. This rejection is respectfully traversed. The applicant disagrees with the tests used by the Examiner to determine patentability. 35 U.S.C. §100(b) states that process "means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material". Clearly, the above claims are directed to a method, which falls within the definition of process.

The Examiner, citing *Gottschalk v. Benson*, states that the above application does not recite a process because the subject matter is not transformed into a different state or thing. However, that same case also states "It is argued that a process patent must either be tied to a particular machine or apparatus or must operate to change articles or materials to a "different state or thing." We do not hold that no process patent could ever qualify if it did not meet the requirements of our prior precedents." Clearly, this caveat has been noted and adopted by the Patent Office, as there are many classes of processes where the subject matter is not changed to a different state. For example, there is an entire subclass devoted to patents on golf swings, i.e. 473/409, many of which are cited by the Examiner himself. The Examiner further seeks to assert that the claims are outside the scope of 35 U.S.C. §101 based on the "useful, concrete, and tangible result" test, first cited in *In re Allapat*. Again, it is believed that the Examiner has misinterpreted the law. This test is used to determine

whether a process which utilizes one of the judicial exceptions (law of nature, natural phenomena and abstract idea) can still be patentable. This test is inappropriate in this case, since the present claims do not utilize any of these judicial exceptions. Consequently, it is believed that all claims are statutorily patentable subject matter.

The Examiner also rejects claims 1-34 under 35 U.S.C. §112 for failing to comply with the enablement requirement. The Examiner states that since the subject matter is non-statutory, one would not be able to perform the claimed invention without undue experimentation. This rejection is also traversed. It appears that the Examiner has confused the test for enablement with that for statutory subject matter. Many things, which are not statutory subject matter, can be fully described so as to enable one of ordinary skill in the art to make and use the proposed invention. For example, the Court in Gottschalk v. Benson denied a patent because "it is conceded that one may not patent an idea". However, there is no disagreement that the method of converting BCD numerals to pure binary numerals as described in that application was sufficiently enabled.

Furthermore, as stated above, the subject matter is believed to be statutory, thereby obviating the Examiner's apparent reason for rejection. Furthermore, the applicant disagrees with the Examiner's assertion that undue experimentation would be needed to perform the claimed golf swing. The specification clearly describes the invention sufficiently, in both words and figures, so as to enable one of ordinary skill in the art to perform the claimed golf swing.

The Examiner rejects claims 1, 2, 4 and 7-12 under 35 U.S.C. §102(b) as being anticipated by Collins (U.S. Patent

No. 5,785,608). The Examiner refers to Figure 8 as support for this rejection. While applicant respectfully disagrees with this basis for rejection, in response, the applicant has amended claim 1 to incorporate the limitations of dependent claims 8 and 9. Thus, newly amended claim 1 states that the target arm is substantially fully extended and parallel to the shaft. The Examiner had previously rejected claims 8 and 9, again citing Figure 8. However, the specification describing Figure 8 states that the golf club "is positioned between the forward arm of the user and the user's ribs". Column 5, lines 42-44. Based on this description, it is clear that the target arm cannot be substantially parallel in total to the shaft, unless the golfer is standing substantially erect, with the club held at the golfer's side (thus making it impossible to swing the club as intended in Collins or the instant application). Closer inspection of Figure 8 in fact shows that the user's target side arm is bent at the elbow; and that the user's target side arm is only substantially parallel to the shaft below the elbow. Therefore, Collins clearly does not anticipate the newly amended claim 1.

The Examiner rejects claims 3,5 and 6 under 35 U.S.C. §103(a) as being unpatentable over Collins in view of another references. Due to the amendment to claim 1, it is believed that these combinations of references do not recite all of the limitations present in claim 1, namely that the target side arm is substantially fully extended and parallel to the shaft.

The Examiner rejects claims 13, 14, 16, 19-23 and 25-29 under 35 U.S.C. §103(a) as being unpatentable over Collins. The Examiner states that Collins describes Figure 8 at column 5, lines 34-50. The Examiner states that although

Collins does not explicitly describe the shaft remaining in the armpit area during the putting stroke, it would have been obvious to do so for a consistent, continuous stroke. This rejection is respectfully traversed. Collins does not explicitly state that the shaft remains in the armpit area, and in fact all figures show exactly the opposite. As stated above, Collins clearly states that the golf club is between the user's arm and ribs. Figure 8 also shows the club is between the arm and the ribs, with the arm bent at the elbow. The golf club cannot both be in the armpit area and between the ribs and the arm, unless the golfer is standing erect, with the club by the golfer's side, thus making it impossible to swing the club as contemplated by Collins or the instant application. Claim 13 has been amended to add the limitations of claims 20 and 21, requiring that the user's arm be substantially fully extended and parallel to the shaft, which Figure 8 clearly does not show. As stated above, Figure 8 clearly shows the user's arm bent at the elbow.

The Examiner also rejects claims 15, 17, and 18 under 35 U.S.C. §103(a) as being unpatentable over Collins in view of additional references.

Because claim 13 has been amended, it is believed that all claims dependent on claim 13 are also in condition for allowance.

The Examiner rejects claims 30-33 under 35 U.S.C. §102(e) as being anticipated by Shioda, and claim 34 as being unpatentable over Shioda. The Examiner states that Shioda discloses the grip style recited in these claims. To further distinguish the present invention, claim 30 has been amended to include recitation of the fact that the golf club travels along the life line of the palm. To perform this

function, the club inherently must enter the palm between the thumb pad and the pinkie pad. This limitation clearly distinguishes the present invention from Figure 14. As stated earlier, this Figure does not show these limitations. Shiода, both in its specifications, drawings and claims, discloses or teaches nothing about where the club enters the hand. Applicant contends that, as shown in Shioda Figures 14, 20 and 21, rather than traveling along the life line through the top of the palm, the club is gripped more in the third, fourth and fifth fingers, and enters the hand across or beneath the pinkie pad, or, as shown in Figure 15 and 23, is not held against the top or side of the hand at all. As further evidence, please note that the pinkie pad is clearly visible in Applicant's Figure 5B, but is nowhere visible in any Shioda figure where the club is gripped between the second and third finger. If Shioda taught the club entering from the top of the palm as Applicant does, the pinkie pad would be clearly visible in those drawings.

The functional differences between these variations in grip are of critical importance to Applicant's invention. As taught by Applicant, having the club enter the target side hand from the top of the palm, travel along the life line and exit between the second and third finger causes the back of the target side hand to more readily align perpendicular to the target line, allowing the golfer to direct the club along the target line by pulling with the back of the target side hand. This method also reduces involvement of the other hand, and can reduce variation in wrist angle. Shioda relies on mechanical means (the shape of the putter grip and the interaction of the hand therewith) for promoting alignment of the club along the target line; is conventional in its approach to wrist angle,

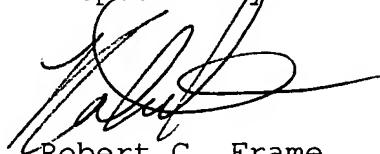
and does nothing to reduce the involvement of the other hand in the swing.

Since Shioda does not disclose that the club travels along the life line and therefore between the thumb pad and the pinkie pad, it cannot anticipate the present invention. Claims 32-33 are believed in condition for allowance due to the amendment to independent claim 30.

The remaining prior art is believed to have been properly not relied upon in rejecting any claim.

Reconsideration and allowance are respectfully requested in view of the foregoing.

Respectfully submitted,



Robert C. Frame

Reg. No. 54,104

176 E. Main Street - Suite 7

Westboro, Massachusetts 01581

TEL: (508) 898-1818